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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/046,452	01/14/2002	Oscar Jimenez	01078	4030
7590	06/04/2004		EXAMINER	
Thomas R. Vigil c/o Welsh & Katz, Ltd. 22nd Floor 120 South Riverside Plaza Chicago, IL 60606			NOLAN, SANDRA M	
			ART UNIT	PAPER NUMBER
			1772	
DATE MAILED: 06/04/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/046,452	JIMENEZ, OSCAR
	<b>Examiner</b>	<b>Art Unit</b>
	Sandra M. Nolan	1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 08 April 2004.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-15 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date. _____.   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____.                                   |

## **DETAILED ACTION**

### ***Claims***

1. Claims 1-15 are pending.

### ***Entry of New Specification***

2. The new specification submitted on 29 December 2003 has been entered. It contains 11 pages and is found in the Office's eDAN/IFW system as a 12-29-03 entry.

### ***Objections/Rejections Withdrawn***

3. The objection to claim 5 set out in section 3 of the 24 June 2003 office action (the last office action) is withdrawn in view of the amendment in the 08 April 2004 response.
4. The 35 USC 112 rejection of claims 1 and 2 expressed in section 4 of the last office action is withdrawn in view of the amendment in the 08 April 2004 response.
5. The 35 USC 112 rejection of claim 2 set out in section 5 of the last office action is withdrawn in view of the amendment in the 08 April 2004 response.

### ***Rejection Maintained***

6. The 35 USC 102 rejection of claims 1-15 recited in section 7 of the last office action is maintained for reasons of record.

### ***New Objections***

#### **Claim Objection**

7. Claims 1-4, 6-8 and 10-13 are objected to because of various informalities. Adoption of the following suggestions would overcome this objection.

In claim 1, it is suggested that "one of" be deleted from line 2.

In claim 2, it is suggested that "one of" be deleted from lines 1 and 2.

In claim 3, it is suggested that –and-- be inserted after “tubing,” in line 1 and that “and” be deleted after “tubing,” in line 2.

In claim 4, it is suggested that “4” be cancelled.

In claim 6, it is suggested that “4” be cancelled.

In claim 7, it is suggested that it is suggested that –and-- be inserted after “tubing,” in line 1 and that “and” be deleted after “tubing,” in line 2.

In claim 8, it is suggested that a space be inserted immediately after “between” in line 2.

In claim 10, it is suggested that “one of” be deleted from line 2.

In claim 11, it is suggested that a space be added immediately after “7” in line 1.

In claim 12, it is suggested that –and-- be inserted after “tubing,” in line 1 and that “and” be deleted after “tubing,” in line 2.

In claim 13, it is suggested that –weight— be inserted after “by” in line 3.

If made, the changes suggested above will correct typographical errors and simplify the claims. Appropriate correction is required.

### ***New Rejection***

#### **Claim Rejections - 35 USC § 102**

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1 and 12-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Acquarulo et al (US 2003/0229184A1; CIP of SN. 10/129,921, filed as a 371 case based on PCT/US00/31174, filed 13 November 2000).

Acquarulo teaches 1 to 20 wt% of nanoclay particles to enhance the flexural and tensile properties of nylon shaft/balloon catheters (see par. 0032). It uses nylon 12 (see par 0028).

***Response to Arguments***

10. Applicant's arguments filed in the 08 April 2004 response have been fully considered but they are not persuasive.

Specifically, the declaration submitted with the 08 April 2004 response does not overcome the 35 USC 102 rejection based on Weber.

The declaration filed on 08 April 2004 under 37 CFR 1.131 has been considered but is ineffective to overcome the Weber reference (US 2003/0065355A1).

The evidence submitted in the 08 April 2004 submission is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the Weber reference. The declaration does not say where the events described occurred.

Furthermore, the declaration submitted on 08 April 2004 is not supported by exhibits of facts or documentary evidence. See MPEP 715.07.

It is suggested that applicant submit a signed declaration containing all of the exhibits referred to in the signed declaration dated 08 April 2004.

***Conclusion***

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Any inquiry concerning this communication should be directed to Sandra M. Nolan, whose telephone number is 571/272-1495. She can normally be reached on Monday through Thursday, from 6:30 am to 4:00 pm, Eastern Time.

If attempts to reach the examiner are unsuccessful, her supervisor, Harold Pyon, can be reached at 571/272-1498.

The fax number for patent application documents is 703/872-9306.

*S. M. Nolan*  
S. M. Nolan  
Primary Examiner  
Technology Center 1700

SMN/smn  
10046452(20040602)